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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/905,338	07/13/2001	Michael I. Watkins	02558B-059411US	6976
20350	7590	02/13/2004	EXAMINER	
TOWNSEND AND TOWNSEND AND CREW, LLP			STUCKER, JEFFREY J	
TWO EMBARCADERO CENTER			ART UNIT	
EIGHTH FLOOR			PAPER NUMBER	
SAN FRANCISCO, CA 94111-3834			1648	

DATE MAILED: 02/13/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/905,338

Applicant(s)

WATKINS ET AL.

Examiner

Jeffrey Stucker

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 22 December 2003.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 21-29 and 50-58 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 21-29 and 50-58 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date <u>7/03 and 12/22/03(x2)</u> | 6) <input type="checkbox"/> Other: _____ |

This Office Action is in response to the Request for Reconsideration filed 22 December 2003. Claims 21-29 and 50-58 are pending and rejected. Applicant states that the Request is in response to the Office Action dated October 23, 2003. This is apparently a typographical error meant to refer to the Office Action mailed July 23, 2003.

The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office Action.

The rejection of claims 21-23, 26, 27, 29, and 54-58 under 35 U.S.C. § 102(e) as being anticipated by Walt et al. (US 6,023,540).

Applicant argues that the Walt et al. reference does not disclose that a composition such as that defined in claim 21 is commercially available or even had been made by Walt et al. or anyone else and that the process of use of the microspheres disclosed does not make the microspheres suitable for use in a multiplex assay that includes the use of flow cytometry.

Applicants arguments have been considered but are not deemed to be persuasive. There is no requirement that every disclosed embodiment of a published invention must be commercially available to proper prior art. The process used by

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Walt et al. is not the basis of the rejection but the materials disclosed in the patent. See previous Office Action.

The declaration filed under 37CFR 1.131 has been considered but is not deemed to be sufficient to overcome the prior art. The patent of Walt et al. has a priority date of 14 March 1997 which antedates the date set forth in the declaration, specifically, 25 September 1997.

Thus, the instant invention is anticipated by Walt et al. (US 6,023,540).

The rejection of claims 21-29 and 50-58 under 35 U.S.C. § 103(a) as obvious over Walt et al. (US 6,023,540) in view of Coulter (GB 1 561 042) is maintained for the reasons set forth above.

Therefore, the instant invention is obvious over Walt et al. (US 6,023,540) in view of Coulter (GB 1 561 042).

The following is a new ground of rejection in view of the art provided on the form 1449 filed 22 December 2003.

The following is a quotation of the appropriate paragraphs of 35 U.S.C. § 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless --

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(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 21-29 and 50-58 are rejected under 35 U.S.C. § 102(b) as being anticipated by JP 61-132869 (" '869").

The instant invention is directed to a composition comprising magnetic microparticles that comprise different subpopulations of discrete size particles that can measure different analytes in the same assay. Various size ranges are claimed as well as a specific surface chemistry.

'869 teaches microparticles for flow cytometry that are different particle diameters and fluorescently labeled. See the last paragraph on page 5. The particles can optionally be magnetized. See the top of page 6 and Figure 7. Thus, the instant invention is anticipated by '869.

No claims are allowed.

Applicant's submission of an information disclosure statement under 37 CFR 1.97(c) with the fee set forth in 37 CFR 1.17(p) on 22 December 2003 prompted the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL.** See MPEP § 609(B)(2)(i). Applicant is

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reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Papers related this application may be submitted to Group 1600 by facsimile transmission. Papers should be faxed to Group 1600 via the PTO Fax Center located in Crystal Mall 1. The faxing of such papers must conform with the notice published in the Official Gazette, 1096 OG (November 15, 1989).

The Group 1600 Official Fax number is: (703) 872-9306.

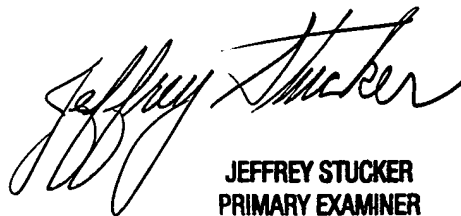
Any inquiry concerning this communication or earlier communications from the examiner should be directed to Jeffrey Stucker whose telephone number is (571)-272-0911. The examiner can normally be reached Monday to Thursday from 7:00am-3:30.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, James Housel, can be reached on (571)-272-0902.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval .

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(PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



JEFFREY STUCKER
PRIMARY EXAMINER